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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,147	05/04/2001	Jacob J. Liu	56647USA8A.002	9714

32692 7590 02/19/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/19/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☒ Responsive to communication(s) filed on 12/27/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8, 10, 11, 19 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

**Office Action Summary**

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Pursuant to the provisions of Rule 126, newly presented claim 20 has been properly renumbered as claim 19.

3. Claims 1-8, 10-11 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the recent claim amendments several problems still remain. In claim 1, next to last line the phrase "disposed against" is vague and indefinite with respect to the bonding relationship which exists between the optical recording medium and the backing layer coated with the adhesive layer, i.e. isn't the optical recording medium bonded by the adhesive layer to the backing? In claims 2 and 3 after the word "block" it appears proper to add "--copolymer--". In claims 6 and 8, line 2 of each, after "of" it also appears proper to remove the colon.

4. Claims 1-8, 10, 11 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -263 combined with applicants' admissions in the specification at page 2 lines 8-11 and 20-22. EP -263 is again relied upon substantially as set forth in paragraph No. 7 of Paper No. 6, disclosing a repositionable genus of articles that can comprise a label bearing (page 4, lines 1-2) low tack or tack-free elastomeric

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block copolymer adhesive that either reads upon or is at most a minor modification of applicants' preferred genus of thermoplastic elastomeric block copolymers. The reference lacks a teaching of adhering the label to an optical recording medium (e.g. a compact disc). However, applicants admit in the aforementioned page 2 of the specification that pressure sensitive adhesive labels for optical discs are well known, and it is imperative that the label must also be precisely positioned onto a disc; therefore a label bearing a repositionable adhesive would be particularly useful for such a task. Accordingly one of ordinary skill in the optical recording medium label art would have more than ample motivation to look to the repositionable adhesive art and utilize a label coated with a member of the genus of adhesives such as are set forth in EP -263 in order to form the claimed genus of articles. Note also that with respect to the claimed performance parameter regarding the storage modulus at room temperature which constitutes the Dahlquist criterion, this performance parameter is again believed to be either inherent in the EP -263 genus of adhesives or at most an obvious optimization to one of ordinary skill, in the absence of unexpected results . With respect to the dependent claims, these are again handled in the manner previously set forth, with the newly presented renumbered claim 19 that recites the presence

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of an ink receptive coating on the backing being well known to one of ordinary skill in the label art.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the patent publication of Liu et al. (the claimed inventor's patent application publication).

6. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

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STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

February 6, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zirker*